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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,548	10/18/2001	Yoshihito Asao	Q66775	5255

7590 12/19/2002

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EXAMINER

NGUYEN, TRAN N

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/978,548

Applicant(s)

Examiner

Tran N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 11-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *SECOND NOTICE TO THE APPLICANT'S NON-RESPONSIVE*

The remaining claims 11-21, which are submitted by the amendment filed on 5/28/02, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

**The originally claims 2-10, particularly the independent claim 2 is drawn to a structure of an alternator apparatus.** The original claim 2 incorporates a recitation of *a method of manufacturing the alternator* in the claimed language, and claims 3-10 are also related to the method of manufacturing the alternator. The method claimed language has been considered as product-by-process feature. As addressed previously in the Office Action, filed on 2/27/02, the method of making the device is **not** germane to the issue of the patentability of the device itself. (*In re Thorpe*, 227 USPQ 964, 966.)

Let's closely study the language of claims 2-10, **particularly claim 2** recites:

*In an alternator having:*

- *a rotor for forming north-seeking (N) and south-seeking (S) poles alternately about a rotational circumference; and,*
- *a stator having a stator core, a polyphase stator winding; and,*
- *an insulating member being interposed between the stator core and the winding;*

wherein the claim's recitation sets more detail structural limitations of the stator core and the winding's configuration.

Thus, claim 2 is a product claim, i.e., claim 2 recites the structure limitations of an alternator.

Regarding the method claimed language, the last two lines recite of claim 2 recite *a method of manufacturing the alternator wherein said insulating member is first disposed on said winding before said winding is inserted into said slots of said stator core*. Claim 3-10 are also related to the method of manufacturing an alternator.

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Examining the claimed language of the independent claim 2, it is clearly a device's structure claim. Therefore, in a device's structure claim, the method of making the device, or its components, does not further limit the structural limitations of the device itself. It has been held that the method claimed language in a device's structural claim is not germane to the issue of the patentability of the device itself. (*In re Thorpe*, 227 USPQ 964, 966.)

The applicant argues that claim 2 does not use the legal terminologies such as "comprising", "consisting of" or "including" as usually set forth in a structure claim, but rather using the term "**having**" so as to indicate the elements of the alternator are included in the preamble defining the intended use or the purpose of the method.

This argument is not persuasive because the claim 2 recitation clearly set detailed structure limitations of an alternator. The use of the terms "comprising", "consisting of" "including" or "**having**" alone is insufficient to determine whether the recitation relates to a structure claim or a method claim.

Furthermore, the applicant's attention is drawn to the original claim 2 which recites specific detail structures of the alternator's parts such as the rotor with polarity location and alternative magnetization, specially the stator's core structure and the stator winding's configuration of inner and outer layers alternately arrange within the stator slots; and, the insulating location between the stator core and the winding. **All these structure limitations are read that claim 2 IS a structure claim of an alternator, not merely preamble of the intended use, or the purpose of the method of manufacturing the alternator.** Thus, the argument state that all of the recitation in claim 2, *except the last two lines*, is merely preamble phrase is **not** persuasive, if not found unreasonable argument.

**Regarding newly added claims 11-21**, let's closely study the language of claims 11-21, each of the respective claim's first line recites:

***A method for manufacturing a stator of an alternator***, the method comprising:

- ***forming said polyphase stator winding by bending*** a plurality of long wire strands to form a plurality of winding portions having straight portions and turn portions;
  - ***disposing insulating members*** around the straight portions of the winding portions;
- and,

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- *inserting the polyphase stator winding in the manner of alternately inner layer and outer layer occupy in a slot depth direction;*
- *dividing the base insulating member by removing the portions of the base insulating member which extend outside the slot*

The claimed language is as clearly and directly as it could be to specifically recite the ***method of making a stator***, not the structure of an alternator, as originally claimed.

Notice that the newly added claims 11-21 change the subject matter that was originally claimed. That is the last two lines of claim 2 recite “a *method of manufacturing the alternator*”, while the added claims 11-21 recite “a method of manufacturing **a stator** of an alternator”, wherein the phrase “of an alternator” is actually a preamble phrase in the claim.

To elaborate this point, claims 11-21 specifically focus on the method of forming only the stator, as a part of the alternator, instead of the method of manufacturing the alternator, as a whole device. Thus, these added claims 11-21 are clearly independent and obviously distinct from the invention originally claimed as in cancelled claims 2-10.

**Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.**

According to the record, the first non-responsive notice was sent on 7/17/02 to inform the applicant that the amendment filed on 5/28/02 is not fully responsive to the prior Office Action, filed on 2/27/02, because the 5/28/02 amendment canceling all claims drawn to the elected invention, *which has received an action on the merits for the originally presented invention*, and presenting only claims drawn to a non-elected invention (MPEP § 821.03).

As the record shows, in the first Non-Responsive Notice, filed on 7/17/02, the applicant was given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, from the mailing date of the 7/17/02 Non-Responsive Notice to supply the omission or correction in order to avoid abandonment.

The record shows that the applicant's second reply, filed on 9/6/02, *again* is **not** fully responsive to the prior Office Action because of the remaining claims 11-21 *are not readable on*

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*the elected invention* for the same reason that was stated in the first non-responsive notice, and again elaboratedly repeated herein.

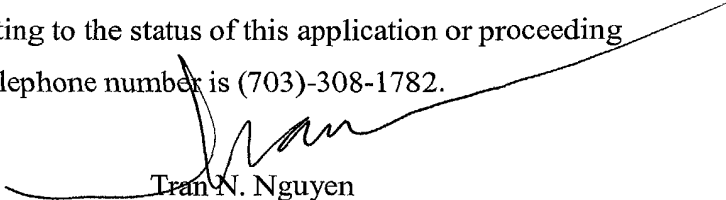
Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. *In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran N. Nguyen whose telephone number is (703) 308-1639. The examiner can normally be reached on M-F 7:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703)-308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703)-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1782.



Tran N. Nguyen

Primary Examiner

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